IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 14407US02)

In the Application of:

Ronald L. Mahany, et al.

Serial No.: 10/692,959

Filed: October 24, 2003

For: WIRELESS PERSONAL LOCAL AREA NETWORK

Examiner: P. B. Nguyen

Group Art Unit: 2464

Conf. No.: 1865

Electronically filed on March 9, 2011

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the Office Action mailed on December 9, 2010. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

In the Office Action of December 9, 2010, claims 10, 12-13, 18, 20-21, 27-28, 31, 33-34, 37-41, 45-49 and 51 were objected to because of informalities. The Examiner asserts that "operable to" is not a positive claim recitation and suggests that everything that comes after it is merely optional. Applicant disagrees and asserts that "operable to" effects a positive claim limitation. The Examiner seems to suggest that a claim recitation is only positive if it recites that the claim element performs its associated function *at all times*. Applicant disagrees and asserts that it is sufficient that the element is operable to perform its associated function. Applicant requests withdrawal of the objection.

Claims 10, 12-16, 18, 20-24, 26, 28-32, 34-45, 48-49 and 51 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,748,655 ("Thrower"). Claim 10 is directed to a transceiver comprising at least one radio unit configured to communicate with both a main communication network and a second radio network. The Examiner asserts that the single mobile telephones 11 and the multi-channel radio telephone unit 15 in FIG. 1 of Thrower comprise a single transceiver that communicates with both the cellular/longer range network of base station 7 and the remote/shorter range network of personal telephones 11. Applicant disagrees. FIG. 2 shows in more detail the multi-channel unit 15 of FIG. 1. FIG. 2 shows that the multi-channel unit 15 actually has two separate transceivers for communicating with the base station 7 and the personal telephones 11. Specifically, the transceiver 20 communicates with the personal telephones 11[1] while the transceiver 26 communicates with the base station 7.[2] In fact, Thrower refers to elements 20 and 26 as receiver/transmitter 20 and receiver/transmitter 26. The very definition of a transceiver is a transmitter/receiver. Since Thrower does not teach a single transceiver that communicates with both the base station 7 and the personal telephones 11, claim 10 is not anticipated by Thrower.

The Examiner argues on page 3 of the Office Action that the entire multi-channel radio telephone unit 15 of Thrower itself constitutes a single transceiver, which is configured to

[1] Thrower, col. 5, lines 44-47, e.g.
[2] Thrower, col. 6, lines 13-18, e.g.

communicate with both the base station 7 and the personal telephones 11. This argument is directly contrary both to the plain language used in Thrower to describe the multi-channel radio telephone unit 15 and the common terminology as would be understood by one of skill in the art. Thrower does not refer to the multi-channel radio telephone unit 15 as a transceiver, nor would one of ordinary skill in the art refer to such as a device as a transceiver. Instead, one of skill in the art would recognize that the multi-channel radio telephone unit 15 would necessarily *contain* transceivers for communicating with the base station 7 and the personal telephones 11. And indeed Thrower does show and describe, with respect to FIG. 2, that the multi-channel radio telephone unit 15 contains two transceivers (receiver/transmitters) 20 and 26, one (transceiver 20) for communicating with the personal telephones 11, and one (transceiver 26) for communicating with the base station 7. Therefore, Thrower does not teach the subject matter of claim 10.

Applicant further submits that the multi-channel radio telephone unit 15 of Thrower would correspond generally to the "wireless network device" of claim 10, in the sense that the multi-channel radio telephone unit 15 is a wireless network device. Of course, the multi-channel unit 15 contains different structure and functionality than the device as claimed in claim 10, but the multi-channel unit 15 is undeniably a wireless network device. Now, note that claim 10 indicates that the transceiver of claim 10 is "for use in" a wireless network device. Since the multi-channel unit 15 is the "wireless network device" in the context of claim 10, it cannot also constitute a transceiver for use in that wireless network device, as that would imply that the multi-channel unit 15 is "for use in" itself. This further demonstrates that it does not make any sense to say that the multi-channel unit 15 of Thrower constitutes the transceiver per claim 10.

For at least the above reasons, Applicant submits that claim 10 and claims 12-17, 26, 29, and 30 depending thereon, are allowable over the cited art.

Independent claims 18, 27, 33, 37, 38, 46, and 51 contain limitations similar to limitations contained in claim 10 and were rejected under similar grounds. Applicant submits that claims 18, 27, 33, 37, 38, 46, and 51, and all claims depending thereon, are allowable for the reasons set forth above with respect to claims 10, 12-17, 26, 29, and 30.

Claim 28 is directed to a transceiver for use in a wireless network device that operates in a communication system that includes a radio network. The Examiner asserts that the communications between the single mobile telephone sets 9 or the multi-channel unit 15 and the personal telephones 11 constitute the radio network per claim 28. According to claim 28, the transceiver is "operable to manage communications of a second wireless network device participating on the radio network with a third wireless network device participating on the radio network." The Examiner asserts that this aspect of claim 28 is taught by the fact that the control unit 28 of the multi-channel unit 15 of Thrower allocates a free channel on which communications may be carried out between the multi-channel unit 15 and the personal telephone 11.[3] However, even is this allocation of a free channel constitutes the multi-channel unit 15 managing communications between itself and a personal telephone 11, it does not constitute managing communications "of a second wireless network device participating on the radio network with a third wireless network device participating on the radio network," per claim. In order to teach this aspect of claim 28, the multi-channel unit 15 would have to manage communications between one personal telephone 11 and another personal telephone 11. This Thrower does not teach. Therefore, claim 28 is not anticipated by Thrower.

Claim 34 and claim 47 include limitations similar to limitations included in claim 28 and were rejected under the same rationale as claim 28 was rejected. Applicant submits that claims 34 and 47 are not anticipated by Thrower for the reasons set forth above with respect to claim 28.

In view of the foregoing, Applicant respectfully requests allowance of claims 10, 12-18, 20-43 and 45-51.

[3] Thrower, col. 6, lines 18-21.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: March 9, 2011

MCANDREWS, HELD & MALLOY, LTD.

/John A. Wiberg/
John A. Wiberg
Reg. No. 44,401
Attorney for Applicant

McAndrews, Held & Malloy, Ltd.
500 West Madison Street
34th Floor
Chicago, IL 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100